

REMARKS

Claims 15 - 45 are pending and under consideration in the above-identified application.

Claims 1-14 stand withdrawn pursuant to a restriction requirement issued on June 25, 2008.

In the Office Action dated October 9, 2008, the Examiner rejected claims 15-45.

With this Amendment, claims 15, 17, 19, 21, 24, 26, 29, 30, 42 and 45 were amended and claims 18, 25, 34 and 41 were cancelled. No new matter has been introduced as a result of the amendments.

I. Objection To Claims

The Examiner objected to claims 29 and 45 for informalities in the wording of the claims. In response, Applicant amended the claims per the Examiner's suggestions. Accordingly, the above objections are now moot. As such, Applicant respectfully requests that the above rejection be withdrawn.

II. 35 U.S.C. § 112 Indefiniteness Rejection of Claims

Claims 17 and 24 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 17 and 24 allegedly did not provide antecedent basis for the term "sulfonating agent." In response to the Examiner's rejection, Applicant amended independent claims 17 and 24 to provide antecedent basis for the term "sulfonating agent." As such, the above rejection is now moot. Accordingly, Applicant respectfully requests that the above rejection be withdrawn.

III. 35 U.S.C. § 103 Obviousness Rejection of Claims

Claims 15-16, 18-23, 25-32, 34-39 and 41-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kitayama et al. (WO 2001/27201)(using U.S. Patent No. 6,827,882 as an English equivalent). Applicant respectfully traverses this rejection.

The claims require a resin composition that includes an aromatic polymer and is flame retardant. The claims also require that sulfonic acid groups and/or sulfonate groups are substituted at a sulfonation rate of 0.01% to 10% onto the aromatic polymer. As a result of the low sulfonation rate required by the claims, the flame retardant has increased compatibility with the resin which results in a high flame-retardant effect and the resin composition has low moisture absorption which results in high preservation stability. Specification, page 13.

The sulfonation rate of 0.01% to 10% may be considered a product-by-process limitation. If the sulfonation rate is considered a product-by-process claim, it should have patentable weight because it imparts distinctive structural characteristics on the final product. *In re Garnero*, 412 F.2d 276, 279 (CCPA 1979). The sulfonation rate of 0.01% to 10% imparts distinctive structural characteristics on the resin composition because it determines the amount of sulfur that is added onto the aromatic polymer. As discussed above, the low sulfonation rate of the claims increases the flame retardant compatibility with the resin and lowers moisture absorption. Accordingly, using a low sulfonation rate imparts distinctive structural characteristics on the resin composition. Thus, the product by process limitation should be given patentable weight.

Kitayama et al. teaches a flame retardant polycarbonate resin that includes, a polycarbonate resin, a polycarbonate copolymer having phosphorous atoms and an anti-dripping agent. Kitayama et al., abstract. However, Kitayama et al. does not teach or even fairly suggest a flame retardant polycarbonate resin where sulfonic acid groups and/or sulfonate groups are

substituted at a sulfonation rate of 0.01 to 10% onto the aromatic polymer. In fact, Kitayama et al. teaches a high sulfonation rate that is 10% to 100%. Kitayama et al., Col. 5 lines 34-36. As such, Kitayama et al. fails to teach or even fairly suggest all the required elements of the claims. Thus, claims 15-16, 19-23, 26-32, 35-39 and 42-45 are patentable over Kitayama et al. Accordingly, Applicant respectfully requests the above rejection be withdrawn.

Additionally, Applicant respectfully requests that the remaining rejections of defendant claims 17, 24, 33 and 40 based in part on Kitayama et al. be withdrawn because Kitayama et al. fails to teach or even fairly suggest all the required elements of the independent claims, which claims 17, 24, 33 and 40 depend from.

IV. Conclusion

In view of the above amendments and remarks, Applicant submits that all claims are clearly allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

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